

REMARKS

Applicants have proposed one count for interference, which recites, in the alternative, each party's independent claims for their inventive molecules (Yanagawa claim 1 and Applicants' claim 40). Applicants believe that their claimed methods of making their inventive molecule (claims 42-44), their methods of simulating protein evolution using the inventive molecule (claims 45-49), and their methods of assaying a protein/protein interaction or protein/nucleic acid interaction using their inventive molecules (claims 50-53) define separately patentable subject matter vis-à-vis the subject matter of claim 40, but for the purpose of administrative convenience, have proposed only one count with all Yanagawa claims (except claim 24) and all of Applicants' claims corresponding thereto.

Applicants draw the Examiner's attention to the fact that this Request parallels Applicants' earlier Request for Interference made in co-pending parent application U.S.S.N. 09/876,235. Since that Request, Applicants have been involved in interference settlement negotiations with the owner of the Yanagawa patent.

Applicants further draw the Examiner's attention to the accompanying Request to Correct Inventorship.

Brief Discussion Of The Involved Claims

Applicants' have added new claims 24-53. Of those new claims, claims 24-39 correspond substantially verbatim to certain claims of Yanagawa '943, as shown below.

Applicants' Claim	Yanagawa '943 Claim
24	1
25	2
26	3
27	4
28	5
29	6
30	10
31	11
32	12
33	15
34	16
35	19
36	20
37	21
38	22

Applicants have not presented any claim that recites subject matter corresponding to Yanagawa independent apparatus claim 24.

Applicants' claims 40-53 do not correspond verbatim to any of the Yanagawa claims, but rather correspond only partially to certain of the Yanagawa claims. Most notably, whereas all of Yanagawa's claims 1-23 recite the phrase "wherein said nucleic acid portion comprises a polymer of nucleoside,"¹ none of Applicants' claims 40-53 recite such a phrase. Rather, Applicants' claims 40-53 recite the phrase "wherein said nucleic acid portion comprises nucleotides," which is supported throughout Applicants' specification.

¹ Yanagawa claim 1 recites the phrase "wherein said nucleic acid portion comprises a polymer of nucleoside." Claims 2-23 depend from claim 1 and thus include that limitation.

Applicants' Claims Are Not Barred Under 35 U.S.C. § 135(b)

The Yanagawa patent issued on March 26, 2002. Applicants' claims 24-53 were copied (as claims 47-76) in an amendment dated September 27, 2002 in parent application U.S.S.N. 09/876,235. Because Applicants' claims were added less than one year after issuance of Yanagawa and because these claims have been continuously pending since that time, Applicants' present claims 24-53 are not barred under 35 U.S.C. § 135(b).

Applicants' Claim 40 Corresponding Exactly To The Proposed Count Is Entitled To The Benefit Of Its Provisional Application Of January 21, 1997

Applicants' claim 40, which corresponds exactly to Applicants' portion of the Proposed Count, is fully supported, in terms of 35 U.S.C. § 112, ¶ 1, by its earliest priority application, namely U.S. Serial No. 60/035,963, filed January 21, 1997 (the “‘963 provisional”). A copy of the ‘963 provisional application is attached hereto as Appendix 1. Support for Applicants' claim 40, which corresponds exactly to Applicants' portion of the Proposed Count is found in the ‘963 provisional *inter alia* at page 2, lines 12-21, page 5, lines 11-12, page 16, lines 1-20, and Figure 1. Applicants' claim corresponding to the Proposed Count is thus entitled to the benefit of the ‘963 provisional application and its filing date of January 21, 1997, and, hence, Applicants should be accorded the benefit of their ‘963 provisional application for the Proposed Count.

Yanagawa's Claims Corresponding to the Proposed Count Are Not Entitled To The Benefit Of Yanagawa's Japanese Priority Application Because JP '855 Provides No Support Under § 112, ¶ 1 For The Phrase "Polymer of Nucleoside" Which Appears In Each Of Yanagawa Claims 1-23, As Well As The Yanagawa Portions Of Proposed Count 1

Yanagawa '943 issued from a U.S. National Phase application corresponding to a PCT Application filed in Japan on October 17, 1997. The Yanagawa PCT application claims priority to Japanese priority application No. 8-274855, filed October 17, 1996 (JP '855"). During prosecution of the '943 patent, Yanagawa filed a certified translation of JP '855 in the U.S. Patent Office. A copy of that certified translation is attached hereto as Appendix 2. A close examination reveals that the phrase "polymer of nucleoside" appears nowhere in JP '855. Indeed, the only discussions of "nucleosides" appear on pages 17 and 19 of the English translation of JP '855, and only in the context of a single nucleoside.²

² See page 17, lines 8-10 and 18-22, and page 19, beginning fourth line from the bottom.

Moreover, the phrase “polymer of nucleoside” also does not occur in the Yanagawa PCT as originally filed. The first occurrence of the term appears to be in the revised Abstract of the Disclosure filed with Yanagawa’s November 24, 2000 Amendment (copy attached as Appendix 3).³ It was also in that Amendment that Yanagawa added the phrase “polymer of nucleoside” to their claims (see Appendix 4 at page 2).

Whether intentionally or through error, Yanagawa introduced a limitation into its claims (“polymer of nucleoside”) that lacks either explicit or implicit support. That is, there is no disclosure that would lead one to believe that Yanagawa was in possession of any invention involving a polymer of nucleosides. For example, the disclosure in the last paragraph of page 19 of the English translation of JP ‘855 refers to the bonding between the nucleic acid portion and the protein portion of the molecule. Puromycin is one of several examples given. In the last few lines of page 19, Yanagawa suggests that a nucleoside or a nucleoside bound to an amino acid via an ester bond may also be used. Clearly, that passage does not suggest a “polymer” of nucleoside.

³ The original Abstract, which was page 85 of the PCT application, does not contain the phrase “polymer of nucleoside.” A copy of the original Abstract is attached as Appendix 5.

The only other disclosure relating to nucleosides is found on page 17 of the English translation of JP '855. That disclosure, however, does not pertain to the use of nucleosides but rather to the use of a substance "analogous to a nucleoside." Specifically, step (d) described on page 17 at lines 8-10 speaks of "bonding . . . a nucleic acid or a substance having a chemical structure analogous to that of a nucleoside and a base" In lines 18-22, it is stated that the "substance having a chemical structure analogous to that of a nucleoside and the base" is puromycin. There simply is no discussion or suggestion of a polymer of nucleoside.

Accordingly, Yanagawa's claims that correspond to the Proposed Count are not entitled to benefit of their JP '855 filing date of October 17, 1996.

Applicants Should Be Accorded Senior Party Status

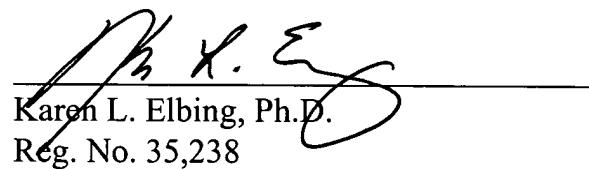
For the reasons set forth above, Applicants have the earliest effective filing date for the Proposed Count. Therefore, Applicants are entitled to Senior Party status upon declaration of the interference. 37 C.F.R. § 1.601(m).

CONCLUSION

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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